

ARGUMENTS/REMARKS

Applicants would like to thank the Examiner for the careful consideration given the present application, and for the personal interview conducted on July 15, 2004, with the Examiner and the Examiner's supervisor. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe and claim the subject matter which applicants regard as the invention.

Claims 2-10 remain in this application. Claim 1 has been canceled.

Claim 7 was rejected under 35 U.S.C. §112, second paragraph, for being indefinite for lacking antecedent basis. The claim has been amended to address this issue, making the rejection moot.

Claims 2-5 and 8-10 were rejected under 35 U.S.C. §102(b) as being anticipated by Johnson (U.S. 4,311,206). Claim 6 was rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of French (U.S. 1,830,198). Claim 7 was rejected under 35 U.S.C. §103(a) as being unpatentable over Johnson in view of Ward (U.S. 4,811,402). For the following reasons, the rejections are respectfully traversed.

Claim 8 recites that "at least a part of said outer surface of said device being formed by a unitary shell member of said device defining an inner space distinct from said channel, said channel being provided in and along said part of said shell member and being formed in the material of said shell member".

It was discussed in detail at the personal interview that the channel of the invention was not taught by the cited references. The Examiner's supervisor suggested that by calling the shell "unitary", and by specifying that the inner space is distinct from the channel, the claim language would clearly overcome the Johnson reference. Further, the supervisor suggested that using the term "in" instead of "within" would further clarify the distinction. Accordingly, applicant has amended the claims to incorporate those suggestions. As such, applicant asserts that claim 8 is thus patentable over the references.

Claims 9 and 10 recited limitations similar to those cited for claim 8 and discussed above. Accordingly, claims 9 and 10 are also patentable over the references.

Claims 2-7, which depend, directly or indirectly, upon one of claims 8 and 9, are thus all patentable over the references for at least the same reasons as the parent claim.

Finally, the Examiner has not provided the proper motivation for combining the references in the rejections of claims for obviousness. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some *suggestion* or *motivation* to modify the reference (MPEP §2143.01). The mere fact that references *can* be combined or modified, alone, is not sufficient to establish prima facie obviousness (*Id.*). The prior art must also suggest the *desirability* of the combination (*Id.*).

Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

In consideration of the foregoing analysis, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

Appl. No. 09/669,042
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Reply to Office action of March 15, 2004

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32992.

Respectfully submitted,

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